

REMARKS

I. Introduction

In response to the pending Office Action, Applicants have added new claims 13-15 so as to recite additional aspects of the present disclosure not previously claimed. No new matter has been added.

Applicants respectfully request reconsideration of the pending rejection of claims 1-12 for the reasons set forth below.

II. The Rejection Of The Claims Under 35 U.S.C. § 103

Claims 1-12 were rejected under 35 U.S.C. § 103 as being unpatentable over JP 63-316405 to Nakamura in view of USP No. 4,186,367 to Chakrabarty. Applicants respectfully submit that claims 1-12 are clearly patentable over the combination of Nakamura and Chakrabarty for at least the following reasons.

As recited by claim 1, the present disclosure relates to a static electricity countermeasure component comprising a varistor layer; and a board laminated with the varistor layer; wherein the varistor layer comprises a material including at least bismuth oxide, the bismuth oxide is diffused to the board by sintering the varistor layer and the board, and a bismuth oxide diffusing layer is provided at the board.

In the pending rejection, it is acknowledged that Nakamura fails to disclose the use of a varistor layer comprising a material including at least bismuth oxide, that the bismuth oxide is diffused to the board by sintering the varistor layer and the board, or that a bismuth oxide diffusing layer is provided at the board. Chakrabarty is relied upon as curing these deficiencies.

Applicants respectfully submit that this rejection is in clear error because there is simply no motivation to combine the references as set forth in the rejection. Most importantly, Chakrabarty is directed to a glass-free thick film varistor. However, as set forth in the Abstract of Nakamura, a glass composition 6 is included in the varistor film. As such, one of skill in the art would not look to the disclosure of Chakrabarty when attempting to modify the device of Nakamura, as Chakrabarty's device is intended for use with glass-free varistor layers, and Nakamura's device is not.

Furthermore, the stated basis for combining the two references set forth in the Office Action is clearly flawed. Once again, the express purpose of Chakrabarty is to provide a glass free varistor paste. The Office Action states that col. 4, lines 33-38 provides the suggestion that it would be desirable to "modify the properties of the varistor", and therefore it would be obvious to modify Nakamura to include a varistor layer with bismuth oxide. However, the cited portion of Chakrabarty does not state that the varistor materials can be selected so as to modify the properties of the varistor. The cited portion just states that using the composition identified in the examples set forth in Chakrabarty results in the "desired varistor properties" that Chakrabarty was seeking. *As Nakamura is not concerned with utilizing a glass-free varistor layer, there is no basis or need for the proposed modification.* The pending rejection is simply "picking and choosing" independent elements from different prior art references and combining them to arrive at the claimed invention, which is clearly improper.

Accordingly, for all of the foregoing reasons, it is respectfully submitted that the combination of Nakamura and Chakrabarty is improper and therefore claims 1-12 are not rendered obvious in view of Nakamura and Chakrabarty.

III. Dependent Claims

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for at least the reasons set forth above, it is respectfully submitted that all pending dependent claims are also patentable.

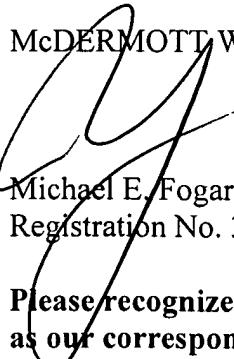
IV. Summary

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited.

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Respectfully submitted,

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